

### REMARKS

New claims 23-30 have been added and are based on canceled claims 1-8, which correspond to the elected embodiment.

Independent claim 23 is based on canceled claims 1 and 2 and recites an optical semiconductor device that includes an optical semiconductor element, a circuit portion on a surface of the semiconductor element, a terminal portion located on a back of the semiconductor element that is electrically connected to the circuit portion, a transparent covering layer and a sealing resin through which a terminal portion is exposed.

An example of this is illustrated in both FIGS. 1A and 1B in which the optical semiconductor element is element 11, the circuit portion is identified by the region 21 enclosed by dashed lines, the terminals correspond to element 17, the covering layer is the hatched region 12 and the sealing resin is region 16.

Applicant notes that the phrase "from the sealing resin" in line 10 of new claim 23 was originally objected by the Examiner as improper English. Applicant disagrees. As is clearly shown in FIGS. 1A and 1B of the present application, a terminal portion 17 is exposed from the sealing resin 16. Therefore, applicant respectfully requests withdrawal of this objection.

In the original Office action of August 11, 2005, now canceled claims 1-8 were rejected as anticipated by JP 2000-173766 or Badehi (U.S. Patent App. No. 2001/0018236).

JP 2000-173766 discloses, for example in FIG. 7(b), a device on a transparent substrate 1, which includes an electroluminescence layer 5 and pixel electrodes 4 connected to selection drive circuits 2. An insulating layer is located between the electroluminescence layer 5 and the substrate 1. A counter electrode, identified by 6, is surrounded by a resin seal layer 33.

The Badehi patent application discloses, for example in FIG. 2A, a microlens array 100 on a substrate 102. Spacers 116 separate the microlens array from a transparent packaging layer 114 that covers the array. Conductive pads 112 electrically connect the substrate 102 to bumps 110 by way of electrical contacts 108 extending along the side of the package. Reference numerals 104 and 118 identify areas of epoxy. Below the epoxy 104 is a glass packaging layer 106.

As discussed below, neither of the above references, taken alone, or together, discloses or suggests the subject matter of new claims 23-30.

Claim 23 recites the “terminal portion is exposed...*near the back* of the optical semiconductor element.” In contrast, FIG. 7(b) of JP 2000-173766 clearly shows the counter electrode 6 is exposed from the resin layer 33 near the transparent substrate 1 at the *front* of the device.

In regards to the Badehi patent, the Office action alleges that the conductive pads 112 also correspond to the “circuit portion” recited in claim 23. Even if the conductive pads were considered to correspond to a “circuit portion,” (which they do not), the conductive pads do not include “any one of a light-receiving element and a light-emitting element” as further recited by claim 23 of the present application. Instead, Badehi discloses the conductive pads 112 “preferably connect substrate 102 to electrical contacts 108” (col. 3, lines 48-49). Therefore, the Badehi patent does not disclose or suggest “a circuit portion including any one of a light-receiving element and a light-emitting element.”

Additionally, the Badehi patent does not disclose a “terminal portion...*exposed from the sealing resin*” as recited in lines 9-10 of pending claim 23. The electrical contact 108 of the Badehi patent, which the Office action alleges corresponds to the “terminal portion,” is formed along the edges of a glass packaging layer 106 and is not exposed from a resin.

Claim 23, therefore, should be allowed for at least the foregoing reasons.

Claims 24-30 depend from claim 23 and should be allowed for at least the same reasons as claim 23.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this

Applicant : Koujiro Kameyama et al.  
Serial No. : 10/812,454  
Filed : March 30, 2004  
Page : 8 of 8

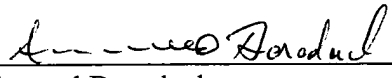
Attorney's Docket No.: 14225-046001 / F1040123US00

paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

An Information Disclosure Statement is enclosed with this Amendment and a check for \$180 in payment of the late submission fee of §1.17(p) is enclosed. No other fee is believed to be due at this time. However, please apply any other charges, or any credits, to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 2/14/06

  
\_\_\_\_\_  
Samuel Borodach  
Reg. No. 38,388

Fish & Richardson P.C.  
Citigroup Center  
52nd Floor  
153 East 53rd Street  
New York, New York 10022-4611  
Telephone: (212) 765-5070  
Facsimile: (212) 258-2291